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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,457	08/14/2000	Eric Boyd	18567-0012	9536
37509	7590	11/18/2004	EXAMINER	
DECHERT LLP P.O. BOX 10004 PALO ALTO, CA 94303			MYHRE, JAMES W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,457

Applicant(s)

BOYD ET AL.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 9-23, 27-37 and 60-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 24-26, 38-59 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on August 23, 2004 under 37 CFR 1.111 is sufficient to overcome the Copple et al (6,178,408), Eggleston et al (6,061,660), and Kamille (5,996,997) references. The above amendment amended Claims 1, 38, 43, 50, and 71. Claims 9-23, 27-37, and 60-70 were previously withdrawn as being directed to a non-elected invention. Therefore, the currently pending claims considered below are Claims 1-8, 24-26, 38-59, and 71.

2. The amendment filed on August 23, 2004 also made numerous changes to the Abstract to determine described the currently claimed invention. These changes are approved.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-8, 25, 26, 50, and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copple et al (6,178,408) in view of Kamille (5,996,997).

Claims 1 and 50: Copple discloses a system for an awards points account, comprising:

a. A main server for providing a user with an interface to submit a code obtained offline and associated with a number of points which may be redeemed by submitting the winning bid in an auction for an item (col 3, line 64 – col 4, lines 34).

While Copple does not explicitly disclose a proxy agent participating in the auction (submitting bids) for the user, Official Notice is taken that such proxy agents were old and well known within the auction arts at the time of the invention. Throughout the centuries, bidders have sent or hired others to represent them at auctions by placing bids in the bidder's behalf. This practice was quickly adopted by online auction sites during the early 1990's and has become commonplace. For example, two of the references cited by the Applicant on the Information Disclosure Statement filed on July 30, 2003 (Paper number 5), references AP (Fisher et al, 5,835,896) and AS (Ausubel, 5,905,975) disclose that such proxy bidding systems (Fisher, col 9, line 18-25)(Ausubel, col 8, lines 28-43) were known as early as 1996. Likewise, Edward C. Baig (Going Once, Going Twice. Cybersold!) and Nancy Tamosaitis (Online Auctions: Bid Adieu to High Prices") disclose online auctions system which also let the bidder enter a maximum amount and the system (online proxy agent) will automatically increase the bidder's offer up to the maximum amount. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such an

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online proxy agent in the Copple auction system. One would have been motivated to include an online proxy agent in order increase the chance of submitted a successful bid by the user without the user having to constantly monitor the online auction (which may last several days).

While Copple discloses that the user submits the coupon from the product or product packaging in order to receive credit for a given number of points, it is not explicitly disclosed how the validity of the coupons (codes) is determined. However, Kamille discloses a similar system for submitting prize codes (coupons) from products or product packaging, and furthers discloses a code server for maintaining valid codes and verifying the validity of the code submitted by the user (col 3, lines 18-35 and col 12, lines 31-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to validate the coupons (codes) submitted by the user in Copple by verifying that the code is in a database of valid codes. One would have been to validate the code in order to ensure that each code (coupon) was only redeemed once by the user in Copple and to prevent fraudulent codes from being processed.

Claims 2-4: Copple and Kamille disclose a system for an awards points account as in Claim 1 above, and Copple further discloses maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code (col 3, line 64 – col 4, line 34).

Claims 5-8: Copple and Kamille disclose a system for an awards points account as in Claim 2 above, and Kamille further discloses that the code may contain any

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number of letters, numbers, and/or characters (col 13, lines 18-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to identify the coupon used in Copple using any number of letters, numbers, and/or characters. One would have been motivated to allow the use of a variable length code on the coupon in order to increase the flexibility of the system to encompass both small and large point systems, i.e. a large system with millions of users submitted multiple codes (e.g. 100) each would require identification codes much larger than a system with only 100 users who submit only 5 codes each.

Claims 25 and 58: Copple and Kamille disclose a system for an awards point account as in Claims 1 and 50 above, and Copple further discloses a means for generating the code and fixing the code onto an offline medium (such as a product or product packaging)(col 3, line 64 – col 4, line 34).

Claims 26 and 59: Copple and Kamille disclose a system for an awards point account as in Claims 25 and 58 above. While Copple further discloses that the code (coupon) is affixed to the product or product packaging, it is not explicitly disclosed that the product packaging is a bottle cap. However, the inside surface of a bottle cap, the sides of plastic or paper food and beverage containers, the inside surface of candy wrappers, etc. are all well known parts of product packaging used to carry and/or conceal game pieces and codes. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the code on the inside of a bottle cap of Copple's product. One would have been motivated to print the code

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on the bottle cap in order to prevent an unauthorized person from removing the code without purchasing the product.

Claim 52: Copple and Kamille disclose a method for an awards point account as in Claim 50 above and Copple explicitly discloses that point systems are known in which the points can be redeemed for a gift or discount (col 1, lines 23-27).

Claims 53 and 54: Copple and Kamille disclose a method for an awards point account as in Claim 52 above, but do not explicitly disclose the type of auction. The Examiner notes that the claimed auction types are all well known types of auctions. Furthermore, the type of auction being conducted has no effect whatsoever on the claimed system of accumulating and redeeming incentive points. Thus, little patentable weight is given to the type of auction or how the auction is run. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to know that any method of determining an item to purchase for which the award points would be redeemed could be used, to include any type of auction, since the procedure has no connection to the incentive awards method.

Claims 55-57: Copple and Kamille disclose a method for an awards point account as in Claim 50 above, and Copple further discloses adding or subtracting points from the account based on the users interaction (point-actionable event) with the system; thus, maintaining a user account containing the points balance for the user and updates the user account after the user submits a valid code (col 3, line 64 – col 4, line 34).

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5. Claims 24 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamille (5,996,997) in view of Copple et al (6,178,408) and in further view of Eggleston et al (6,061,660).

Claims 24 and 51: Copple and Kamille disclose a system for an awards point account as in Claims 1 and 50 above, but do not explicitly disclose that the user account would be placed behind a firewall and further protected using encryption. However, Eggleston discloses a similar system for awarding promotion points to a user's account which further discloses placing the user account behind a firewall and using passwords to increase the security of the account data. While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data and, thus, would have been an obvious addition to the security measures disclosed by Eggleston. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the use account data in Copple. One would have been motivated to use encryption in order to prevent unauthorized disclosure of the information, especially if duplicate data was being stored on a smart card carried by the user as disclosed by Eggleston.

6. Claims 38-41, 43, 44, and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copple et al (6,178,408).

Claims 38 and 43: Copple discloses a system for earning and redeeming incentive points, comprising:

a. A network with multiple servers including at least an auction server and a store server (col 3, line 64 - col 4, line 34). It is inherent that the servers connected to the same network (e.g. the Internet in Copple) would be accessible to a user also connected to the same network; and

b. A user database of user accounts holding incentive points earned by the user (col 4, lines 8-11) which may be redeemed by submitting the winning bid in an auction of an item (col 6, lines 7-24 and 57-63).

While Copple does not explicitly disclose a proxy agent participating in the auction (submitting bids) for the user, Official Notice is taken that such proxy agents were old and well known within the auction arts at the time of the invention. Throughout the centuries, bidders have sent or hired others to represent them at auctions by placing bids in the bidder's behalf. This practice was quickly adopted by online auction sites during the early 1990's and has become commonplace. For example, two of the references cited by the Applicant on the Information Disclosure Statement filed on July 30, 2003, references AP (Fisher et al, 5,835,896) and AS (Ausubel, 5,905,975) disclose such proxy bidding systems (Fisher, col 9, line 18-25)(Ausubel, col 8, lines 28-43) were known as early as 1996. Likewise, Edward C. Baig (Going Once, Going Twice. Cybersold!") and Nancy Tamosaitis (Online Auctions: Bid Adieu to High Prices") disclose online auctions system which also let the bidder enter a maximum amount and the system (online proxy agent) will automatically increase the bidder's offer up to the maximum amount. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such an online proxy agent in the

Copple auction system. One would have been motivated to include an online proxy agent in order increase the chance of submitted a successful bid by the user without the user having to constantly monitor the online auction (which may last several days).

Claims 39 and 44: Copple discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, and further discloses the user obtaining a code offline, submitting the code, and being credited with points when the code is determined to be valid (col 3, line 64 - col 4, line 26).

Claims 40 and 46: Copple discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, and further discloses that the interacting with the servers comprises registration, attention to an ad, or a purchase (col 3, line 64 – col 4, line 52).

Claims 41 and 47: Copple discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, and explicitly discloses that the points can be redeemed as payment for submitting the winning bid in an auction (col 3, line 64 – col 4, line 34).

Claim 48: Copple discloses a system for earning and redeeming incentive points as in Claim 43 above, and further discloses the network and servers are the Internet and an Internet server (col 3, line 64 – col 4, line 34).

7. Claims 42, 45, 49, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copple et al (6,178,408) in view of Eggleston et al (6,061,660).

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Claims 42, 45, and 49: Copple discloses a system for earning and redeeming incentive points as in Claims 38 and 43 above, but does not explicitly disclose placing the user account behind a firewall and using passwords to increase the security of the account data. However, Eggleston discloses a similar system for awarding promotion points to a user's account which further discloses placing the user account behind a firewall and using passwords to increase the security of the account data. While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data and, thus, would have been an obvious addition to the security measures disclosed by Eggleston. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the use account data in Copple. One would have been motivated to use encryption in order to prevent unauthorized disclosure of the information, especially if duplicate data was being stored on a smart card carried by the user as disclosed by Eggleston.

Claim 71: Copple discloses an Internet system for maintaining a database of user point accounts which can be used as bids in an auction for an item and which are temporarily removed from the user account when the bid is submitted and permanent removed from the user account if the bid is the winning bid in the auction (col 3, line 64 – col 4, line 34; col 6, lines 7-24 and 57-63). Copple also discloses that point systems were known which set fixed dates or time limits for redeeming the points for promotional items (col 1, line 45 – col 2, line 16). This implies that if the user does not redeem the points by the fixed date or within the set time limit, the points would become invalid (i.e.

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removed from the user account). The Examiner notes that this was very common during the early days of frequent flyer point systems in which the points earned by a user had to be used within 12 months. At the end of the time period the points were invalidated and subtracted from the user's account. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention to set a time limit or expiration period for the accrued points for the user in Copple. One would have been motivated to set an expiration period and to subtract the expired points from the user's account in order to allow the service provider (point awarder and redeemer) to better manage the system as discussed by Copple.

While Copple does not explicitly disclose a proxy agent participating in the auction (submitting bids) for the user, Official Notice is taken that such proxy agents were old and well known within the auction arts at the time of the invention. Throughout the centuries, bidders have sent or hired others to represent them at auctions by placing bids in the bidder's behalf. This practice was quickly adopted by online auction sites during the early 1990's and has become commonplace. For example, two of the references cited by the Applicant on the Information Disclosure Statement filed on July 30, 2003, references AP (Fisher et al, 5,835,896) and AS (Ausubel, 5,905,975) disclose such proxy bidding systems (Fisher, col 9, line 18-25)(Ausubel, col 8, lines 28-43) were known as early as 1996. Likewise, Edward C. Baig (Going Once, Going Twice. Cybersold!") and Nancy Tamosaitis (Online Auctions: Bid Adieu to High Prices") disclose online auctions system which also let the bidder enter a maximum amount and the system (proxy agent) will automatically increase the bidder's offer up to the

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maximum amount. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a proxy agent in the Copple auction system. One would have been motivated to include a proxy agent in order increase the chance of submitted a successful bid by the user without the user having to constantly monitor the online auction (which may last several days).

While Copple does not disclose that the user account is protected using encryption, Eggleston discloses a similar system for awarding promotion points to a user's account which further discloses placing the user account behind a firewall and using passwords to increase the security of the account data. While it is not explicitly disclosed that the account data will also be encrypted, encryption is a well known security measure used to protect data and, thus, would have been an obvious addition to the security measures disclosed by Eggleston. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the use account data in Copple. One would have been motivated to use encryption in order to prevent unauthorized disclosure of the information, especially if duplicate data was being stored on a smart card carried by the user as disclosed by Eggleston.

Response to Arguments

8. Applicant's arguments with respect to claims 1-8, 24-26, 38-59, and 71 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner will briefly respond to the arguments.

The Applicant's argument in reference to the newly added proxy agent have been addressed in the new rejections above.

The Applicant's argument in reference to the accessibility of the web server from either the auction web server or the store web server is non-persuasive. Copple discloses that the servers are all connected through a network (i.e. online). All computers connected to an open network, such as the Internet, are inherently accessible to all others, unless it is explicitly disclosed that a limiting device (e.g. firewall) is placed in front of one of the servers. Copple has no such explicit disclosure.

In reference to the Applicant's request for references to show that all auction types are known, the Examiner notes that the Applicant has not indicated either in the claims or in the specification that a new type of auction has been developed. Rather the specification and claims both list various well known types of auctions. If the Applicant is attempting to claim a new type of auction, the Examiner suggests the specific new auction type and the novel features thereof be identified within the specification.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

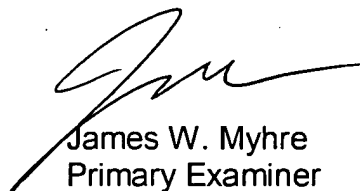
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

November 15, 2004



James W. Myhre

Primary Examiner

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